

REMARKS

Claims 1-3, 6-8 and 10-16 were pending at the time of the Office Action, of which claims 1 and 13 are independent. In this Amendment, a minor grammatical correction has been made in the next to last paragraph of claim 13, the last paragraph of independent claims 1 and 13 have been amended to clarify an aspect of the inventions and claim 6 has been amended to update its dependency. Support for the substantive amendments to the last paragraphs of claims 1 and 13 is found in, for example, FIG. 3B and paragraphs [0052]-[0053] of the application-as-published. Claims 1-3, 6-8 and 10-16 are now active in this application. Care has been exercised not to introduce new matter.

Claim Objection

Claim 6 was objected to because claim 6 depends from cancelled claim 5. In response, claim 6 has been amended to depend from claim 1. Withdrawal of the objection is respectfully requested.

Claim Rejection under 35 U.S.C. § 103

Claims 1-3, 6-8 and 10-16 were rejected under 35 U.S.C. § 103(a) as being obvious over Thomas et al. (U.S. Publication No. 2003/0037068) in view of Candelore et al. (WO 03/090401, hereinafter “Candelore”) in view of Proehl (U.S. Patent No. 6,614,844, hereinafter “Proehl”). The rejection is respectfully traversed for the following reasons.

Amended claim 1, in pertinent part, recites as follows:

“a controller which, when said main data stored in said memory is rendered, detects an ID code assigned to said main data, compares the detected ID code with an ID code assigned to said sub data stored in said memory and judges whether said sub data associated with said main data under rendering has already been read from said memory and its video rendered and, unless said detected ID code assigned to said main data agrees with said ID code assigned to said sub data stored in said memory, regards said sub data video as not having been rendered and changes substitute data embedded in said main data and associated in advance

with said sub data into video data and incorporates said substitute data into said main data and makes said video data render when said main data is rendered.”

As disclosed in Applicants’ FIG. 3B, one example of what is recited in claim 1, if CM content 2 (CM2) is skipped over in the reading or playback process and program data 2 (PM2) is going to be rendered immediately after program content 1 (PM1) is rendered, the ID code stored in the memory is "001", whereas the ID code of the program data that has just been read is "002." Thus, there is a mismatch between the two ID codes (S4, the No branch) and commercial data skipped over in the playback process has been detected. Consequently, the status flag is reset to 0 (S6) and CM-substitute data is incorporated into the program data (S7), and then, the program video is displayed (S7). The incorporation unit 18 incorporates the generated CM-substitute data into the program data and the CM-substitute information is superimposed in a predetermined position on the program video which is displayed on the monitor display 20. (See paragraphs [0052]-[0053] of the present application-as-published)

The proposed combination of Thomas, Candelore and Proehl fails to disclose the limitations of claim 1 with regard to the ID codes and the incorporation of the substitute data into the main data for rendering.

As admitted by the Examiner on page 5 of the Office Action, Thomas and Candelore fails to disclose the limitations of claim 1 regarding “a controller which, when said main data stored in said memory is rendered, detects an ID code assigned to said main data, compares the detected ID code with an ID code assigned to said sub data stored in said memory and judges whether said sub data associated with said main data under rendering has already been read from said memory and its video rendered and, unless said detected ID code assigned to said main data agrees with said ID code assigned to said sub data stored in said memory, regards said sub data video as not having been rendered and changes substitute data embedded in said main data and

associated in advance with said sub data into video data and incorporates said substitute data into said main data and makes said video data render when said main data is rendered.”

Turning to Proehl, the watermark is superimposed onto the video stream during the modified playback mode when the video stream is not properly reproduced. In contrast, claim 1 requires the “substitute data” to be incorporated “into said main data” and the “video data,” which includes “the substitute data,” to be “rendered when said main data is rendered.” The rejection instead looks to Proehl to allegedly make up for the admitted deficiency of the basic combination of Thomas and Candelore.

Next, Proehl’s watermark is added to selected key frames in the video stream in order to act as bookmarks by which the selected key frames can be easily located. Proehl is silent on judging whether the watermark, which indicates location of the selected key frames, is rendered or not. In contrast, claim 1 requires the “controller” to “judge[s] whether said sub data associated with said main data under rendering has already been read from said memory.”

Finally, Proehl is silent on “compare[es] the detected ID code with an ID code assigned to said sub data stored in said memory.”

Hence, Proehl does not suggest the “controller” as recited in the last paragraph of claim 1, and the combination relying on Proehl to meet the recitation on point does not in fact satisfy requirements of independent claim 1.

Accordingly, as each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness (*see*, M.P.E.P. § 2143.03) and for at least the foregoing reasons the proposed combination of Thomas, Candelore and Proehl fails to do so, it is respectfully submitted that claims 1 and claims dependent thereupon are patentable over the combination of Thomas, Candelore and Proehl.

Amended claim 13 recites the same subject matter as claim 1. Therefore, claim 13 and claims dependent thereupon are patentable over the cited prior art for the same reasons as claim 1.

CONCLUSION

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Hosang Lee
Limited Recognition No. L00,295

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 KEG/HL:cac
Facsimile: 202.756.8087
Date: August 11, 2008

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as our correspondence address.**